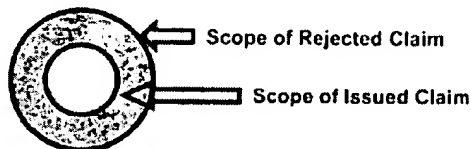


REMARKS

Claims 23-25 are rejected based upon the Examiner's position that the "output means" of col. 16, line 1 should be "rejected material conveyor." Applicant respectfully disagrees. The output means collects material that passes through the trommel screen, and this material is what is being received by the stockpiling conveyor. The rejected material conveyor removes coarse material that has traveled through the trommel without passing through the trommel screen. Therefore it is believed that claims 23-25 are allowable in their present form.

The Examiner has rejected claims 26-52 under 35 U.S.C. § 251 as being an improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. The Examiner cited some pertinent case law supporting his position and concluded that because the application shows that the broadened aspect (in the reissue) "relates to subject matter that applicant previously surrendered during prosecution of the application," the claims are subject to rejection. However, in a case rendered subsequent to the cases cited by the Examiner, on May 29, 2003 the Board of Patent Appeals rendered its decision in *Ex Parte Eggert*, 67 U.S.P.Q.2d 1716 (Bd. Of Patent Appeals and Interferences, 2003). In that case, the Board dealt with the issue of whether the fact that claims had been amended during the original prosecution meant that those amendments could not be removed in a subsequently-filed broadened reissue. The Board answered that question in the negative, ruling that it is only necessary that the claims be narrower than the originally submitted claims that were rejected, prior to the submission of the Amendment. The Board made reference to Drawing 1 in its Opinion.



The Board then stated:

There came a time in the prosecution of the '992 application that claim 1 (once amended) was presented for examination and was met by a final rejection from the examiner under 35 U.S.C. § 103. At that time, appellants were presented with a number of options for proceeding with the quest for patent protection. One was to appeal the examiner's final rejection of claim 1 (once amended) to this Board. Another was to concede that rejected claim 1 (once amended) was unpatentable and to amend that claim in an attempt to define narrower, patentable subject matter. Appellants chose the latter option and amended claim 1 a second time. Upon consideration of claim 1 (twice amended), the examiner determined that it was patentable. Thus, claim 1 (twice amended) became issued claim 1.

The changing scope of a claim during the administrative examination process as it is amended to overcome prior art rejections can be viewed as a series of concentric circles. As illustrated in Drawing 1, the scope of rejected claim 1 (once amended) is the outer circle and the scope of amended issued claim 1 (twice amended) is the inner circle. The shaded area between the circles represents subject matter which is only narrower than the scope of the rejected claim but only broader than the scope of the issued claim. In our view, the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter appellants conceded was unpatentable. The subject matter of the shaded area was not subject to the administrative examination process as the examiner was never directly presented with a claim which fell within the scope of the shaded area. Thus, appellants have never conceded that a claim falling within the scope of the shaded area of Drawing 1 is unpatentable and therefore, in our view, such subject matter is not barred by the recapture rule.

Therefore, simply because language added by the amendments of March 13 and April 27, 1998 is not included in independent claims 26, 35, 36, 41, 42 and 52 does not mean that that language needs to be in any broadened reissue. What it means is that the claims must be narrowed in some respect from the claim that had been rejected prior to the Amendment.

Original application claim 1 is shown alongside new independent claim 26:

Original Application Claim 1

1. A portable trommel comprising:
 - a chassis, including support wheels at one end thereof for movement of the trommel;
 - a trommel rotatably mounted on the chassis and having an input and an output end;
 - input means for supplying material to be screened to the input end of the trommel, the input means being mounted on the chassis adjacent the input end of the trommel;
 - output means for collecting material passing through the trommel screen, the output means being mounted on the chassis, below the trommel; and
 - a stockpiling conveyor mounted on the chassis and having a lower end adapted to receive screened material from the output means and having an upper end for discharging screened material to form a stockpile.

Reissue Claim 26

26. A trommel vehicle comprising:
 - a frame assembly supported for travel over a ground surface;
 - a material handling elongate trommel mounted on the frame assembly having input and output ends; and
 - a deployable elongate material distribution conveyor mounted on the frame assembly adjacent the trommel's output end, movable relative to the frame assembly about two angularly displaced axes, and having a first and a second component, the first component operatively interposed between the second component and the frame assembly, where the first component and second component move relative to each other during adjustment of the conveyor between deployed and stowed conditions, and where adjustment of the conveyor toward its stowed condition tends to minimize its gravitational projection and adjustment toward its deployed condition tends to enlarge its gravitational projection.

It can be seen that instead of the broad language merely reciting: "a stockpiling conveyor mounted on the chassis and having a lower end adapted to receive screened material from the output means and having an upper end for discharging screened material to form a stockpile," new claim 26 recites in much narrower fashion the deployable elongate material distribution conveyor. Therefore, the scope of claim 26 falls within the shaded area of the drawing found in the *Eggert* opinion. As such, it is not an improper recapture of broadened subject matter surrendered in the application for the original patent.

The same is true as to the other independent claims added in the reissue application.

Original application claim 1 and new claim 35 are shown below:

Original Application Claim 1

1. A portable trommel comprising:
a chassis, including support wheels at one end thereof for movement of the trommel;
a trommel rotatably mounted on the chassis and having an input and an output end;
input means for supplying material to be screened to the input end of the trommel, the input means being mounted on the chassis adjacent the input end of the trommel;
output means for collecting material passing through the trommel screen, the output means being mounted on the chassis, below the trommel; and
a stockpiling conveyor mounted on the chassis and having a lower end adapted to receive screened material from the output means and having an upper end for discharging screened material to form a stockpile.

Reissue Claim 35

35. A trommel vehicle comprising:
a chassis supported for travel over a ground surface;
a material handling elongate trommel mounted on the chassis having input and output ends; and
a deployable elongate material distribution conveyor mounted on the chassis adjacent the trommel's output end, movable relative to the chassis about two angularly displaced axes, and having a first and a second component, the first component operatively interposed between the second component and the chassis, where the first component and second component move relative to each other during adjustment of the conveyor between deployed and stowed conditions, and where adjustment of the conveyor toward its stowed condition tends to minimize its linear extension and adjustment toward its deployed condition tends to enlarge its linear extension.

Like claim 26, the "deployable elongate material distribution conveyer..." language is more narrow than the "stockpiling conveyor..." language of application claim 1.

Claim 36 is shown below, alongside original application claim 1:

Original Application Claim 1

1. A portable trommel comprising:
a chassis, including support wheels at one end thereof for movement of the trommel;
a trommel rotatably mounted on the chassis and having an input and an output end;
input means for supplying material to be screened to the input end of the trommel, the input means being mounted on the chassis adjacent the input end of the trommel;
output means for collecting material passing through the trommel screen, the output means being mounted on the chassis, below the trommel; and
a stockpiling conveyor mounted on the chassis and having a lower end adapted to receive screened material from the output means and having an upper end for discharging screened material to form a

Reissue Claim 36

36. A trommel vehicle comprising:
a chassis supported for travel over a ground surface;
an elongate trommel mounted on the chassis having input and output ends; and
a deployable conveyor having at least a pair of relatively moveable elongate components mounted on the chassis adjacent the output end of the trommel movable relative to the chassis about angularly displaced first and second axes, where the first and second axes intersect.

stockpile.

Again, the "deployable conveyor..." language is more narrow than the "stockpiling conveyor..." language of application claim 1.

As shown below, the same is true with respect to reissue independent claims 41, 42, 50 and 51:

Original Application Claim 1

1. A portable trommel comprising:
a chassis, including support wheels at one end thereof for movement of the trommel;
a trommel rotatably mounted on the chassis and having an input and an output end;
input means for supplying material to be screened to the input end of the trommel, the input means being mounted on the chassis adjacent the input end of the trommel;
output means for collecting material passing through the trommel screen, the output means being mounted on the chassis, below the trommel; and
a stockpiling conveyor mounted on the chassis and having a lower end adapted to receive screened material from the output means and having an upper end for discharging screened material to form a stockpile.

Reissue Claims 41,42, 50 and 51

41. A trommel vehicle comprising:
a chassis supported for travel over a ground surface;
an elongate trommel mounted on the chassis having input and output ends; and
a deployable elongate conveyor mounted on the chassis adjacent the trommel's output end, moveable relative to the chassis about two angularly displaced intersecting axes, and having first and second relatively moveable elongate components, the first component being operatively interposed between the second component and the chassis, the first component and second component being moveable between deployed and stowed conditions, where in the stowed condition the first component extends generally upwardly from the chassis.
42. A trommel vehicle comprising:
a chassis supported for travel over a ground surface;
an elongate trommel mounted on the chassis having input and output ends; and
a deployable elongate conveyor having first and second elongate components where the first component is mounted on the chassis adjacent the output end of the trommel and is movable relative to the chassis about angularly displaced first and second axes, and where the second component articulates with the first component about a third axis as the conveyor moves between a deployed and stowed condition.
50. A portable trommel comprising:
a chassis, including support wheels at one end adapted to allow movement of the portable trommel;
a trommel rotatably mounted on the

chassis and having an input end, an output end, and a trommel screen;

a fines conveyor for collecting material passing through the trommel screen, the fines conveyor mounted on the chassis beneath the portable trommel; and

a stockpiling conveyor mounted on the chassis for receiving screened material from the fines conveyor, the stockpiling conveyor comprising a first lower part and a first upper part, wherein the first lower part has a lower and upper end such that the lower end is pivotally attached to the chassis and the upper end is pivotally attached to the first upper part, such that the first lower and the first upper parts of the stockpiling conveyor are movable between an extended, operational position, in which the stockpiling conveyor extends upwardly and outwardly from the chassis and a retracted transportable position in which at least a portion of the first upper part of the stockpiling conveyor extends above the first lower part, and in which the lower end of the first lower part of the stockpiling conveyor is mounted to the chassis for rotation about a vertical axis to enable the stockpiling conveyor to form an arc shaped stockpile.

51. A portable trommel comprising:

a chassis, including support wheels at one end adapted to allow movement of the portable trommel;

a trommel rotatably mounted on the chassis and having an input end, an output end, and a trommel screen;

a fines conveyor for collecting material passing through the trommel screen, the fines conveyor mounted on the chassis beneath the portable trommel; and

a stockpiling conveyor mounted on the chassis for receiving screened material from the fines conveyor, the stockpiling conveyor comprising a first lower part and a first upper part, wherein the first lower part is pivotally attached to the chassis and the first upper part is pivotally attached to the first lower part, the first lower and the first upper parts being movable between an extended, operational position and a retracted position for transportation in which the first upper part does not extend remotely beyond the first lower part, and where the first lower part of the stockpiling conveyor has a lower end mounted to the chassis for rotation about a


vertical axis, to enable the stockpiling conveyor to form an arc shaped stockpile.

For the foregoing reasons, because the reissue claims include a more narrow definition of the stockpiling conveyor, the scope of all of the reissue claims for within the shaded area of the *Eggert* opinion and therefore are not an improper recapture of broadened subject matter surrendered in the application for the original patent.

It is respectfully requested that the Examiner reconsider his rejection and that all pending claims be passed to issuance. If any questions remain, the Examiner is encouraged to call the undersigned at 503-224-6655.

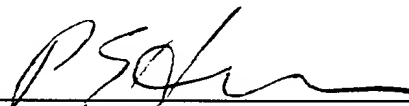
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on January 8, 2004


Anita R. Tabayoyon

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